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JAN 13 2006

Attorney's Docket No. UNIQA-0030

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5      In re application of:      Sharif et al.  
Serial No.:      09/901,405  
Filed:      07/08/2001  
For:      "System and method for using an Internet appliance to  
send/receive digital content files as E-mail attachments"  
10     Group No.:      2143  
Examiner:      Unknown (previously Jude Jean-Giles)

15     Via First Class Mail  
Mail Stop: Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
20

LETTER ACCOMPANYING BRIEF ON APPEAL

Dear Sir:

25

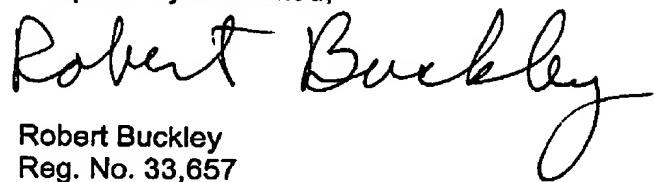
The undersigned practitioner has filed two Notices of Appeal in this matter and cannot recall any valid reason for having done so. The undersigned then forgot to file a timely Brief on Appeal. On the date this letter and Brief were deposited with the U.S. Postal Service six months had not yet elapsed from the mailing of the Final Office action. Thus the 30 case has not been abandoned, but it is unclear what additional action or fee might be required.

The applicants have submitted a petition for an extension of the time to file of three months and the appropriate fee paid by deposit account. If the fee paid is too small please charge an appropriate fee to the deposit account, or if too large return any unused portion 35 of the fee to that deposit account. If other action is required, please advise and provide a

limited time for compliance. The fault is entirely that of the undersigned, was not intentional and was the result of carelessness.

Respectfully submitted,

5

  
Robert Buckley  
Reg. No. 33,657

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BRIEF ON APPEAL

**Real Party in Interest:** The real parties in interest are the applicants Imran Sharif, Shabbir Husain, and Pijush Chakraborty.

**Related Appeals and Interferences:** None.

**Status of Claims:** Claims 1 – 11 are pending, rejected, and are the subject of this appeal.

**Status of Amendments:** No amendment was filed subsequent to final rejection.

**Summary of Claimed Subject Matter:**

Claim 1 defines a system (FIG. 19) for exchanging digital content files as email attachments. The system 1904 includes a system server 1908 and an Internet appliance

1910 – 1914 that communicate via an external communications network 1902. This system structure permits the system server and the Internet appliance, acting as a client (specification at page 5, lines 26 – 27), to divide the task of storing, selecting and downloading user interface screens, creating and editing email, storing, selecting and attaching digital content files to an email, and sending the email with its attachments to an external email server 1906 via the communications network (specification at page 6, lines 1 – 5).

The system server 1908 stores and retrieves user interface screens and digital content files (specification at page 6, lines 1 – 5, and page and implements a standard electronic mail protocol for sending and receiving email and digital content email attachments using the communication network.

A typical system includes more than one Internet appliance (1910 – 1914 of FIG. 19). Each Internet appliance communicates with the system server for selecting and retrieving user interface screens, and provides video/audio outputs compatible with a standard television receiver for displaying user interface screens downloaded from the system server. Each Internet appliance also receives a reduced keyset keystroke sequence used to control selection of options displayed on the user interface screens via the television set, to create and edit email messages, and to select digital content files for attachment to an email.

In the typical system a user operates a hand-held device (claim 2) to create and transmit the reduced keyset keystroke sequence to an Internet appliance.

Claim 3 defines the hand-held device as a remote control unit which communicates with the Internet appliance using an infra-red beam.

Alternatively, claim 4 defines the hand-held device as a wireless telephone communicating with the Internet appliance using wireless telephone technology.

Claim 5 adds a standard television receiver to the system of claim 1 for viewing email, attachments, user interface screens and providing audio output.

Claim 6 defines a claim 1 system email creation protocol.

Claim 7 defines a claim 1 system email editing protocol.

Claim 8 defines a claim 1 system email selection protocol.

Claim 9 defines a claim 1 system email address handling protocol.

Claim 10 defines a claim 1 system email attachment protocol.

Claim 11 defines a claim 1 system email audio attachment protocol.

**Grounds of Rejection to be Reviewed on Appeal:**

1. Claims 1 – 3 and 5 – 11 are rejected under 35 USC 102(e) as being anticipated by Dawson (U.S. 6,252,588 B1).
2. Claim 4 is rejected under 35 USC 103(a) as being unpatentable over Dawson (US 6,252,588 B1) in view of Chang et al. (US 6,598,076 B1).

**Argument:**

A. **Claims 1 – 3 and 5 – 11 are not anticipated by Dawson (US 6,252,588 B1).**

Though not specifically using the phrase "networked system," the two major elements of the claim 1 system, the system server 1908 and the Internet appliance 1910 – 1914, divide the work load in a server/client relationship and communicate with each other via the external communication network 1902.

Dawson teaches a black box (Dawson FIG. 18, element 1801) that performs some of the same operations but that is not divided between a system server that stores user screens and digital content files and a simple appliance that handles the reduced keyset keystroke sequence device and interfaces with a television set. Everything is done in the same black box. Thus, claim 1 organizes the system in a manner not disclosed by Dawson.

The examiner takes the position that the communication network 1902 is an element of the claim 1 system because nowhere does claim 1 explicitly state that the communication network is external to the system. Thus the examiner is able to find that every element of claim 1, or its equivalent, is disclosed in Dawson.

Yet, the same communication network 1902 is used by the system server 1908 to communicate with the external email server 1906 (claim 1, lines 3 – 5). The examiner has not taken the position that the external email server is also an element of the claim 1 system. Including the communication network 1902 in claim 1 while not including the email

server 1906 would appear to be inconsistent with the examining corps position of giving the broadest possible scope to the language of a claim. FIG. 19 illustrates the proper relationship of the structural elements of claim 1. FIG. 19 is consistent with the language of claim 1. Neither the communication network 1902 nor the email server 1906 is positively claimed as an element. Each is referred to in claim 1 in an indirect way. All the "elements" of claim 1 are positively set forth. This is evidence that the communication network and the email server are not structural elements of the claim. The examiner has not rejected the claim under 35 USC 112; therefore one can assume that he did not feel confused about the meaning of the claim.

The communication network 1902 and the email server 1906 are external to the structure of claim 1, therefore Dawson does not disclose every element of claim 1 and the rejection under 35 USC 102(e) is improper.

Claims 2, 3 and 5 – 11 depend directly or indirectly from claim 1 and thus are believed to be patentable over Dawson.

**B. Claims 1 – 3 and 5 – 11 are not rendered obvious by Dawson (US 6,252,588 B1).**

There appears to be nothing in Dawson suggesting the benefits of modifying the Dawson black box to separate the system server function from the Internet appliance function by interposing an external communication network. It is submitted that a person of ordinary skill would not be so motivated and that claims 1 – 3 and 5 – 11 are not unpatentable under 35 USC 103(a).

**C. Claim 4 is patentable over Dawson (US 6,252,588 B1) In view of Chang et al. (US 6,598,076 B1).**

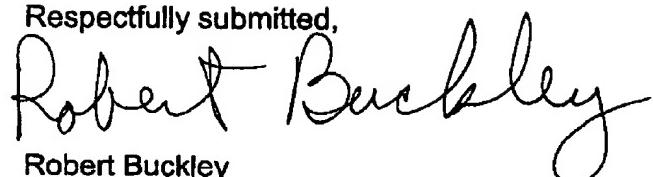
If the Board is persuaded by the argument above that Dawson does not disclose every element of claim 1, or its equivalent, then the examiner has failed to establish a *prima facie* case supporting the combination with the Chang et al. wireless telephone as the hand-held device of claim 4.

FROM :ROBERT BUCKLEY

FAX NO. :208-728-4835

Jan. 13 2006 07:13PM P10

Respectfully submitted,



Robert Buckley  
Reg. No. 33657

**Appendix – Claims on Appeal**

- 1        1. (previously amended) A system for exchanging digital content files as email attachments, comprising:
  - 3              a system server connected to a communications network and implementing a standard electronic mail protocol for sending and receiving email and digital content email attachments via the communications network;
  - 6              the system server having storage and retrieval means for a plurality of user interface display screens and digital content files;
  - 8              an Internet appliance for receiving a reduced keyset keystroke sequence, a connection with the communications network for establishing a client relationship with the system server, a browser for accessing user interface display screens via the network connection, a video/audio converter providing output signals compatible with a standard television receiver for display of accessed user interface display screens, and hyperlink selection means responsive to the received keystroke sequence for navigating an accessed user interface display screen;
  - 15             the user interface screens and the reduced keyset keystroke sequence defining a text entry and editing protocol, an email creation and addressing protocol, an email viewing protocol, and an email deletion protocol;
  - 18             the user interface screens and the reduced keyset keystroke sequence also defining an email attachment selection protocol permitting selection of digital content files for attachment to a user created email;
  - 21             the system server including means responsive to the email attachment selection protocol and the reduced keyset keystroke sequence for retrieving a selected digital content file, and for encoding the retrieved file as a standard email attachment;
  - 24             the system server including means for establishing a connection via the communications network with a standard email server, and for sending an email and the encoded attachment to the email server using the standard email protocols;
  - 27             the system server including means for establishing a connection via the communications network with the email server for receiving email and encoded

29 attachments, for decoding the attachments, for storing the received email and decoded  
30 attachment, and for notifying the Internet appliance that an email and attachment has been  
31 received.

1 2. (previously amended) The system of claim 1, further including hand-held reduced keyset  
2 means for creating and transmitting the reduced keyset keystroke sequence.

1 3. (previously amended) The system of claim 2, wherein the hand-held reduced keyset  
2 means defines a remote control unit that transmits the reduced keyset keystroke sequence  
3 as an infra-red beam, and wherein the Internet appliance is adapted for receiving the infra-  
4 red beam.

1 4. (previously amended) The system of claim 2, wherein the hand-held reduced keyset  
2 means defines a wireless telephone, and wherein the Internet appliance is adapted for  
3 receiving the reduced keyset keystroke sequence from the wireless telephone.

1 5. (previously amended) The system of claim 1, further including a standard television  
2 receiver connected to receive the converted video/audio output signals for display of user  
3 interface display screens and embedded hyperlinks, including system email protocol  
4 display screens, received emails, entered text, screens permitting text editing, digital  
5 content file selection, and email recipient address selection and entering.

1 6. (original) The system of claim 1, wherein the defined email protocols include a user  
2 interface display screen and keystroke parsing engine for converting a reduced keyset  
3 keystroke sequence to text and displaying the text as the body of a new email.

1 7. (previously amended) The system of claim 1, wherein the defined email protocols  
2 include a user interface display screen and keystroke parsing engine for interpreting a  
3 reduced keyset keystroke sequence as editing commands for entered text within the body  
4 of the new email and for displaying an editing process.

- 1    8. (original) The system of claim 1, wherein the defined email protocols include a user  
2    interface display screen and parsing engine permitting a reduced keyset keystroke  
3    sequence to access a display of available digital content files, and selecting a digital  
4    content file for attachment to a new email.
  
- 1    9. (original) The system of claim 1, wherein the defined email protocols include a user  
2    interface display screen and parsing engine permitting a reduced keyset keystroke  
3    sequence to display available email recipient addresses, to edit a displayed address, and  
4    to enter a new email recipient address.
  
- 1    10. (original) The system of claim 1, wherein the defined email protocols include a user  
2    interface display screen and parsing engine permitting a reduced keyset keystroke  
3    sequence to select a display of a list of received emails and email attachments.
  
- 1    11. (previously amended) The system of claim 1, wherein the defined email protocols  
2    include a user interface display screen and parsing engine permitting a reduced keyset  
3    keystroke sequence to select and view a received email, and to select and view/listen to  
4    email attachments.